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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/530,447	04/28/2000	YOSHINORI KAMI	01165.0782	6878

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EXAMINER

PATTERSON, MARC A

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 09/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/530,447

Applicant(s)

KAMI ET AL.

Examiner

Marc A Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

REPEATED REJECTIONS

1. The 35 U.S.C. 103(a) rejection of Claims 10 – 11, 13, 15 and 17 – 21 as being unpatentable over Toray Industries (Japanese Patent No. 0790747), of record on page 2 of the previous Action, is repeated.

The 35 U.S.C. 103(a) rejection of Claims 9, 14 and 16 as being unpatentable over Toray Industries (Japanese Patent No. 0790747) in view of Smith et al (U.S. Patent No. 5,378,019), of record on page 4 of the previous Action, is repeated.

The 35 U.S.C. 103(a) rejection of Claim 12 as being unpatentable over Toray Industries (Japanese Patent No. 0790747) in view of Mizuki et al (U.S. Patent No. 5,637,385), of record on page 4 of the previous Action, is repeated.

ANSWERS TO APPLICANT'S ARGUMENTS

2. Applicant's arguments regarding the 35 U.S.C. 103(a) rejection of Claims 10 – 11, 13, 15 and 17 – 21 as being unpatentable over Toray Industries (Japanese Patent No. 0790747), 35 U.S.C. 103(a) rejection of Claims 9, 14 and 16 as being unpatentable over Toray Industries (Japanese Patent No. 0790747) in view of Smith et al (U.S. Patent No. 5,378,019), and 35 U.S.C. 103(a) rejection of Claim 12 as being unpatentable over Toray Industries (Japanese Patent No. 0790747) in view of Mizuki et al (U.S. Patent No. 5,637,385), of record in the previous Action, have been carefully considered but have not been found to be persuasive for the reasons set forth below.

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Applicant argues, on page 7 of the May 19, 2004 communication, that the range of 21000 – 31000 of Toray is at an entirely different level from the property of weave fineness recited in the claims although the fabrics of Toray and the claimed invention have almost the same cover – factor values.

However, Toray discloses that the weave fineness is selected to obtain a desired permeability (paragraph 0032, English translation). Therefore, one of ordinary skill in the art would have recognized the utility of varying the weave fineness to obtain a desired permeability. Therefore, the permeability would be readily determined through routine optimization of weave fineness by one having ordinary skill in the art depending on the desired end use of the product.

It therefore would be obvious for one of ordinary skill in the art to vary the weave fineness in order to obtain a desired permeability, since the permeability would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end result.

Applicant also argues, on page 7, that even an estimated tensile work at break for Toray would be well outside the claimed range, preventing an overlap of the claimed ranges. However, Toray teaches the selection of physical properties, including tensile strength (paragraph 0062, English translation), for the purpose of obtaining desired mechanical properties and flexibility (paragraph 0063, English translation).

Therefore, one of ordinary skill in the art would have recognized the utility of varying the physical properties to obtain desired mechanical properties and flexibility. Therefore, the mechanical properties and flexibility would be readily determined through routine optimization

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of physical properties by one having ordinary skill in the art depending on the desired end use of the product.

It therefore would be obvious for one of ordinary skill in the art to vary the physical properties in order to obtain desired mechanical properties and flexibility, since the mechanical properties and flexibility would be readily determined through routine optimization by one having ordinary skill in the art depending on the desired end result.

Applicant also argues, on page 8, that Boesch and Slaney is inapposite to the facts of this case because of the lack of overlap of the cited ranges.

However, as discussed above, Toray provides motivation for the optimization of the disclosed ranges to include the claimed ranges to obtain a desired permeability and mechanical properties.

Applicant also argues on page 8 that a showing of unexpected results does not appear to be a requirement in mechanical cases.

However, although unexpected results are not necessarily required in any case, in the present case unexpected results may distinguish the claimed invention from prior art which can be modified to obtain the claimed invention. Furthermore, it has not been explained why the enhanced properties which Applicant states are characteristic of the claimed invention are unexpected.

3. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc Patterson, whose telephone number is (571) 272 – 1497. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached at (571) 272 – 1498. FAX communications should be sent to (703) 872-9310. FAXs received after 4 P.M. will not be processed until the following business day.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pairedirect.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217 - 9197 (toll - free).

Marc A. Patterson, PhD.

Marc Patterson
Art Unit 1772

Nasser Ahmad
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PRIMARY EXAMINER
Acting SPE
8/31/04